

REMARKS

Claims 1 and 16 are pending in this application. Claim 16 is withdrawn from consideration from the Examiner as directed to a non-elected invention. By this Amendment, claims 1 and 16 are amended, and claims 2-15 and 17-19 are cancelled. Support for the amendments to claims 1 and 16 can be found, for example, at page 16, line 24 – page 21, line 11, page 32, line 8 and page 64, lines 3-27 of the originally filed specification. No new matter is added.

In view of the amendments and the following remarks, reconsideration and allowance of the application are respectfully requested.

I. Restriction Requirement

By this Amendment, claim 16 is amended to depend from claim 1. Upon allowance of the product claim 1, Applicants respectfully request rejoinder and examination of claim 16.

II. Allowable Subject Matter

Applicants thank the Examiner for the indication that the elected compound, Example 2, is in condition for allowance. By this Amendment, the subject matter of Example 2 is incorporated into claim 1, and claims 2-15 and 17-19 are cancelled. Accordingly, the allowance of claim 1 is respectfully requested.

III. Claim Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner rejects claims 1-15 and 17 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. By this Amendment, claims 2-15 and 17 are cancelled, rendering their rejection moot.

As to claim 1, the term “hydrocarbon group” has been deleted or, in the case of variable “Y,” has been amended to recite “a C₁₋₆ hydrocarbon group.” One of ordinary skill in the art would understand the meaning of a C₁₋₆ hydrocarbon group, as the specification provides several examples. See, e.g., specification at page 17, line 7 – page 18, line 2. Therefore, the subject matter of claim 1 is clearly described in the specification. Accordingly, reconsideration and withdrawal of the rejection are respectfully request.

IV. Claim Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejects claims 1-15 and 17 under 35 U.S.C. §112, second paragraph, as being indefinite for the definition of “A.” By this Amendment, claims 2-15 and 17 are cancelled, rendering their rejection moot. As to claim 1, Applicants respectfully traverse the rejection.

By this Amendment, claim 1 is amended to recite “A is a group remaining from elimination of hydrogen from cimetidine.” As a result, the parent compound in the prodrug compound of claim 1 is cimetidine, which corresponds to the elected species of Example 2. One of ordinary skill in the art would understand the chemical structure of cimetidine, and would understand that a prodrug of a compound of Formula (I) corresponds to Example 2. Therefore, claim 1 is definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

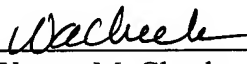
V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 16 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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